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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,274	04/02/2001	Masaki Ichihara	040447/0231	8800
22428 7590 07/16/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
CHAMPAGNE, DONALD				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
07/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/822,274

Applicant(s)

ICHIHARA, MASAKI

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Final Drawing Review (PTO-640)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 April 2005 has been entered.

Review of Proposed Allowable Matter

2. Allowable matter was suggested in the Office action mailed on 8 February 2005, incorporated into applicant's amendment filed on 8 April 2005, and modified by a proposed examiner's amendment made of record in July 2005. Further examination found that allowance could not be justified. A new non-final rejection follows.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1- 41 are rejected under 35 U.S.C. 103(a) as being obvious over Goldhaber et al. (US005794210A) in view of Rakavy et al. (US005913040A).
5. Goldhaber et al. teaches (independent claims 1 and 25) a rewarding method and a server, the method comprising:

(a) designating a predetermined keyword¹ object (*Cybercoin 62* and the *thumbnail description* of the associated ad in Fig. 11, col. 15 line 66 to col. 16 line 5 and col. 16 line

¹ Applicant is put on notice that "keyword" is non-functional descriptive material. The examiner is not required to give patentable weight to non-functional descriptive material (MPEP § 2106.01). In the sense used in the patent law (35 USC 101), a "keyword" is not functional because it is neither "tied to a

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61) to each of a plurality of advertising web pages (col. 7 lines 27-29 and 48-50 and col. 8 lines 50-51) having respective URLs;

(b) causing a *server 106* (col. 16 lines 42-46) to detect that a user of a user terminal unit (*consumer computer 104*) has selected the keyword object on one of a plurality of the advertising web pages;

(c) causing a transfer of cash or credit to the user's account (col. 7 lines 51-54; col. 16 lines 46-52; col. 16 line 65 to col. 17 line 3; and col. 17 lines 33-36 and 44-53), which reads on recording an event log correlating an identifier of the user, an identifier of the selected keyword object, and an event that the keyword object has been selected,

(d) determining whether or not the number of *Cybercoins*/keyword objects recorded in the event log exceeds a first predetermined value (the purchase price of *particular specified product*, col. 11 lines 25-31), and

(e) rewarding the user (be delivering said *particular specified product*) when the determined result at step (d) is "yes".²

6. Goldhaber et al. does not teach recording date of selection. Rakavy et al. teaches recording the time of ad display (col. 12 lines 61-65), which reads on recording date of selection. Because Rakavy et al. teaches that the value of an ad can be time dependent (col. 7 lines 51-53 and col. 13 lines 2-3), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Rakavy et al. to those of Goldhaber et al.
7. In addition, under *KSR v. Teleflex* (82 USPQ 2d 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Goldhaber et al. teaches every feature of the claims except recording the date of ad selection. Rakavy et al. teaches recording the time/date of selection and further teaches that time/date of selection/display can affect the value of the ad.
8. Neither reference teaches determining if the recording was within a predetermined time period. However, because Rakavy et al. teaches that the value of an ad is time dependent,

particular apparatus" nor "operates to change materials to 'a different state or thing'" (IN RE COMISKEY, CAFC 2006-1286, September 2007).

² This clause contains optional language. Applicant is put on notice that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim

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it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Rakavy et al. and Goldhaber et al. that it be determined if the recording was within a critical predetermined time period.

9. Goldhaber et al. also teaches at the citations given above claims 2, 3, 5, 6, 8-10, 12-18, 22-24, 26, 27, 29, 30, 32-37 and 41. Goldhaber et al. also teaches claims 19 and 38 (col. 9 lines 62-63).
10. Goldhaber et al. does not teach (claims 4, 11 and 28) a banner ad and rewarding by discounting an Internet connection fee. Official notice is taken (MPEP § 2144.03) that banner ads and rewarding by discounting an Internet connection fee were well known at the time of the instant invention. Because it is efficient to use common practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these features to the teachings of Goldhaber et al.
11. Traverse of the taking of Official Notice - On p. 11 of the arguments filed on 3 December 2004, applicant has traversed the examiner's taking of official notice (in para. 8 above). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained. Since applicant failed to successfully traverse the examiner's assertion, it is taken to be admitted prior art (MPEP 2144.03.C).
12. Goldhaber et al. does not teach (claims 7, 20-21 and 39-40) storing the user ID and the event log on the user terminal unit. Because this could minimize response time and server storage requirements, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add storing the user ID and the event log on the user terminal unit to the teachings of Goldhaber et al.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The

language that does not limit a claim to a particular structure (MPEP § 2111.04). The examiner does not have to give patentable weight to optional claim language.

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examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

14. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

3 July 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688